

REMARKS

The communication mailed October 30, 2003 has been received and reviewed. Claims 1-3, 8, 10, 18, 21 and 22 are pending in the application and are subject to a restriction requirement.

Responsive to the restriction requirement, applicants provisionally elect the claims of Group II, *i.e.*, claims 2, 3, 8 and 9 drawn to a SMAD interacting protein SIP1 (SEQ ID NO: 2) that does not interact with XSMAD1 in yeast, classified in class 530, subclass 350. This provisional election is made with traverse.

Applicants respectfully traverse the restriction requirement since (i) the pending claims of the above-referenced application were previously subject to a restriction requirement in the parent application; (ii) the claims of the above-referenced application comply with the unity of invention requirement because the claimed sequences have a common technical feature; (iii) the applicants have paid for an international search report and a preliminary examination report in the parent application and are, therefore, entitled to have more than one sequence examined under M.P.E.P. § 1850; (iv) the applicants have twice paid for the examination of the pending claims, *i.e.*, in the parent application and in the above-referenced, pending application, and it would be unfair to the applicants to pay for the examination of more claims; and (v) some of the claims are directed to products and the process of producing the products, thus applicants claim the right of rejoinder for some of the claims.

In traversing the restriction requirement, the applicants request that the claims directed to the SMAD interacting proteins SIP 1 and SIP 2 be prosecuted together. Thus, applicants request that the claims of Groups II and III, *i.e.*, claims 2, 3, 8, 9, 18 and 22, be examined together.

Since the Commissioner for Patents determined that "normally ten sequences constitute a reasonable number [of sequences] for examination purposes," it would not be an undue burden on the Office to Examine to examine the claims directed to SEQ ID NO: 2 and SEQ ID NO: 4. Further, since the applicants paid for an international search report and a preliminary examination report in the parent case, under M.P.E.P. § 1850, the Office has determined that up to four additional sequences per group is a reasonable number of sequences for examination. Thus, it should not be an undue burden on the Office to examine two sequences.

The above-referenced, pending application is a divisional of U.S. patent application no. 09/449,285, filed November 24, 1999, now U.S. Patent 6,313,280. The parent application had claims directed to nucleic acid sequences encoding SEQ ID NOS: 2 and 4 allowed. Since the parent application had more than one sequence examined, it would not be an undue burden on the Office to examine more than one sequence in the above-referenced, pending application. Further, since the claims of the parent application were previously subjected to a restriction requirement, it would be unfair to make the applicants pay for the examination of more claims in, yet, a third application.

It also would not be an undue burden on the Office to examine the claims directed to SEQ ID NOS: 2 and 4 since the sequences share a common technical feature, *i.e.*, they are both SMAD interacting proteins. This is exemplified by the fact that the restriction requirement indicated that the claims directed to SIP 1 and SIP 2 are both classified in class 530, subclass 350. (*See, Restriction Requirement*, page 2).

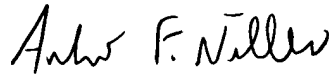
Applicants also submit that “[a]ny claims which have been restricted and nonselected and which are limited to allowable sequence(s) will be rejoined and examined.” (M.P.E.P. § 803.04). Thus, the prosecution of any claims including SEQ ID NOS: 2 and 4 should not be a burden on the Office since claims including the sequences SEQ ID NOS: 2 and 4 were allowed in the parent case.

Lastly, Applicants claim a right of rejoinder to have process claim 1 rejoined since claim 1 is commensurate in scope with the product of claim 2. (*See, M.P.E.P.* § 821.04).

CONCLUSION

If questions exist after consideration of the foregoing, the Office is kindly requested to contact the applicants' representative at the address or telephone number below.

Respectfully submitted,



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